

Applicant respectfully takes exception to the Examiner's statement that the intermediate products (Claims 13-22) are deemed to be useful for treating insects. The statement is apparently made to indicate that the intermediates have a use other than for the synthesis of the products of Claims 1-12. If the Examiner is aware of scientific evidence that fluorocarbohydrides are useful as insecticides, Applicant would be interested in the information. If the Examiner has no evidence on the subject, the statement should be withdrawn.

The Examiner requires Applicant to elect an ultimate disclosed species to which claims will be restricted if no generic claim is finally held allowable, and to list all claims readable thereon. The requirement was said to have been made by telephone to Applicant's attorney, and the Examiner states that the elected species is that wherein R is the base recited in Claim 1 at lines 25-30, wherein R² is hydroxy. The Examiner states that Claims 1-2 and 11-12 read on the elected "species", and that all other embodiments are considered by the Examiner to be patentably distinct and are withdrawn under 37 C.F.R. 1.142(b). The Examiner says that Applicant must affirm the election.

Applicant believes that some clarification is called for.

The election, as made, is not an election of a species, but an election of a subgenus. There are two variable groups in the elected base -- R², which is hydroxy, and R³, which may be hydrogen, bromo, chloro, or iodo. Thus, four species have been elected.

Further, according to the note made at the time of the telephone call by Applicant's attorney, the election required

was of "a particular base", not a particular species.

Accordingly, Applicant is now unsure how to proceed. The application is not, at present, under the election of species practice, because no species has been elected. Rather, it appears that the application is actually being restricted essentially according to the same multi-way restriction scheme that was set out in the first Action in the parent case, Serial No. 677,146. In that case, the restriction scheme regarded each base moiety as a separate invention, and it appears that the same scheme is actually being followed in this case.

Applicant also notes that the Examiner said that other embodiments (including specifically Claims 3-10) are considered patentably distinct and are withdrawn under 37 C.F.R. 1.142(b). That rule is entitled "Requirement for Restriction", and the rule which governs the election of species practice is 1.146. Thus, the citation of 1.142(b) further reinforces Applicant's belief that a requirement for restriction, not for election of species, is really being made.

Further, Applicant was advised to consider deleting the non-elected subject matter and inserting a subgeneric claim readable on the elected "species". However, under the election of species practice, deletion of claims is not in order, because the next step is a complete action on the merits of all claims readable on the elected species. M.P.E.P. 809.02(c). If that action results in allowance of Claim 1, the claims to non-elected subject matter will be no longer withdrawn, since they are fully embraced by Claim 1. M.P.E.P. 809.02(c)(2)(i).

It follows, therefore, that the Examiner's advice to delete subject matter is in keeping with a restriction requirement, but not with an election of species.

The Examiner is therefore requested to reconsider the purported election of species requirement, and to recast it in the form of a requirement to restrict, if that action is in order in the circumstances.

However, Applicant must affirm the telephonic election. Accordingly, pending further action from the Examiner, Applicant provisionally affirms the election of the "species" wherein R is the base recited in Claim 1, lines 25-30, and R² is hydroxy, and agrees that Claims 1-2 and 11-12 read on the elected "species". If a requirement to restrict similar to that in the parent case is made, Applicant will elect the same subgenus to be prosecuted in this case.

Claims 11-12 were rejected under 35 U.S.C. 112, on the ground that the invention was not adequately described because of the lack of a specific virus inhibited by the compounds and compositions. The amendments to those claims make the rejection moot, and follow the same pattern adopted in the parent application.

Claims 1-2 were rejected for double patenting over the issued parent patent, and Claims 11-12 were rejected for obviousness-type double patenting over the parent. Claim 1, from which the other claims depend, has now been amended to remove the subject matter of the parent patent from it. Since the parent issued with a narrow scope as a result of a restriction requirement, and Claim 1 has been amended in accordance therewith, the double patenting rejections are moot because the parent is excluded from use as a reference by 35 U.S.C. 121.

Conclusion

In summary, Applicant has made amendments which cancel the claims of the Examiner's restriction Group II; which avoid

the rejection under Section 112; and which remove the parent's claimed subject matter. Applicant has affirmed the election under the requirement to restrict. Applicant has asked for clarification of the purported requirement to elect a species, being of the opinion that a further requirement to restrict is actually intended. The telephonic election of a subgenus, rather than of a species, has been provisionally affirmed, pending clarification of the requirement.

Withdrawal of the rejections under 35 U.S.C. 112 and 101 and entry of the amendments are requested. Clarification of the purported election of species is requested as well.

Respectfully submitted,



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